

S/N 10/783,872  
AMENDMENT

ATTY DOCKET NO. 0253-0001

### REMARKS

This amendment is intended to respond fully to the Office action mailed July 28, 2005, and to place this application in condition for allowance.

#### Election

Election of the invention of Group I, claims 1-15 is affirmed.

#### Drawings

The Examiner objected to the drawings under 37 CFR 1.83(a), stating that the tubular elongate members of claim 4 must be shown. Reconsideration is requested. Upon reconsideration, it is noted that the generally tubular members 14, 16 are shown in Figs. 1-4 of the drawings, as described in the description, paragraph 0014:

[0014] Each member 14, 16 is preferably rigid to prevent fence 10 from collapsing if animals try jumping over fence 10 to enter the garden or into fence 10 in an attempt to collapse it. In one embodiment, each member 14, 16 is generally tubular, and preferably, each member 14, 16 is generally cylindrical, as shown in FIG. 2, having a diameter that is large enough to provide strength and durability to member 14, 16, yet small enough so that fence 10 does not block too much light from the plants in the garden....

#### Claim rejections - 35 USC section 103

Claims 1-3 and 6-14 have been rejected under 35 USC 103 (a) as unpatentable over Rowan, US patent 3,484,081. Reconsideration is requested.

Initially, it is noted that Rowan, US patent 3,484,081 is not listed in the PTO-892, and therefore it is not clear whether this reference is actually of record in this application. It is requested that the Examiner list this reference in a PTO-892.

Independent claims 1, 12 and 14 have been amended to clarify that applicant's fence module is continuous and unbroken in nature, unlike the units shown in the Rowan patent, by addition of the language, each of said upper and lower crossbars comprising a

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continuous, solid and unbroken member, and also by clarifying that the row of elongate members joined by these crossbars comprises a pair of end members and a plurality of intermediate members.

Upon reconsideration, it is noted that the only fence module described in Rowan which would have been obvious to one of ordinary skill in the art at the time the invention was made is the assembly shown in Fig. 5 of the drawings thereof. Rowan clearly teaches in the Abstract of the Disclosure: "A picket fence for easy assembly is provided in which a series of individual picket units are hingedly engaged with each other. Each unit consists of a picket, rails attached near the top and bottom of the picket, dowels to engage the rails and pegs to support the rails on the dowels in vertical alignment with each other." (emphasis added). Moreover, claim 1 of the Rowan patent recites "a picket fence comprising a series of repeating units hingedly engaged with each other to form a fence of any desired length and design, each repeating unit comprised of: a vertically elongated picket; a pair of rails mounted on each picket . . . a dowel . . . and pegs . . ." (emphasis added).

Referring to claim 1, 12 and 14, it cannot be seen how one of ordinary skill in the art would have found obvious such features of the claimed module as a plurality of generally parallel elongate members, upper and lower crossbars connecting the plurality of elongate members in a row, which row has a pair of end members and a plurality of intermediate members, each of said upper and lower crossbars comprising a continuous, solid and unbroken member and a spacing between the elongate members of between about 1 in. and about 2 1/2 inches. In this regard, Rowan clearly teaches that the pickets, and the dowels which serve the function of supporting the fence units and extending beneath the ground surface, are separate members. In contrast, applicants claimed invention uses the same elongate members as both pickets and support members.

In other words, the Rowan reference fails to place the invention in the possession of one of ordinary skill in the art as required by 35 USC 102, and fails to render the claimed invention obvious under 35 USC 103. Any modification to the structure of Rowan to achieve the structure of claim 1 would not be an obvious one, since there is no teaching or motivation in the Rowan reference to make such modifications. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ("the reference must

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describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it").

The anticipating reference "must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.1991). *MPEP 706.02(j) Contents of a 35 U.S.C. 103 Rejection*

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)

This is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999), citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 UPSQ 303, 313 (Fed. Cir. 1983)

In addition to the foregoing, and also with respect to spacing of the elongate members between about 1 in. and about 2.5 in., the Rowan reference fails to teach or

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suggest the functional considerations addressed by the novel design of applicants claimed fence module, as set forth for example in the applicant's description in the paragraphs reproduced below:

[0005] What is needed is a sturdy, easy-to-install garden fence for discouraging burrowing animals from entering a garden, and that is easy to remove when needed.

[0011] Referring to FIG. 1, a modular fence 10 is shown for preventing burrowing animals, such as rabbits, from entering a garden in order to prevent the animals from damaging plants in the garden.

[0015] Each member 14, 16 has an upper end 18 and a tapered lower end 20, wherein tapered lower end 20 is inserted into the ground 2 to a predetermined depth D to stabilize module 12 in an upright position and to provide a barrier below ground level 4 comprised of buried lower portions 28 of members 14, 16 so that if a burrowing animal attempts to dig under fence 10, it will encounter buried lower portions 28 which it cannot bypass because of the close spacing S between members 14, 16.

[0016] Buried portions 28 of members 14, 16 should be long enough to discourage the burrowing animals from entering the garden, but not so long that it is difficult to install fence 10, particularly in hard earth, or so that buried portions 28 make fence 10 overly expensive due to the cost of material needed for longer members 14, 16. In one embodiment, tapered lower ends 20 of members 14, 16 extend at least about 3 inches, preferably between about 3 inches and about 9 inches, still more preferably between about 4 inches and about 6 inches beyond lower crossbar 24.

Accordingly, the Rowan reference, having failed to recognize the problem addressed by applicant cannot be said to render the solution, i.e., the claimed invention, obvious. Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness. See, e.g., In re Antle, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971) (warning against selection of prior art with hindsight). *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998).

With respect to claims 2, 3, 6, 7, 8, 9, 10, 11 and 13, the above amendments in clarification of independent claims 1, 12 and 14, that applicant's fence module is

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continuous and unbroken in nature, unlike the units shown in a Rowan patent, by addition of the language, each of said upper and lower crossbars comprising a continuous, solid and unbroken member, is believed to render these rejections moot.

For the foregoing reasons, Applicant respectfully requests reconsideration and allowance of all claims as amended.

If the Examiner believes it would help to advance the prosecution, the undersigned attorney would welcome the opportunity to discuss the application in a further telephone interview and can be reached at (312) 201-0011.

Respectfully submitted,

Dated this 26<sup>th</sup> day of October, 2005.



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